IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED : 07.07.2009

CORAM

THE HONOURABLE MR.JUSTICE M.VENUGOPAL

A.S.NO.1010 OF 2001

Sri Pattatharasiamman Textiles
Registered Firm, rep. by its
Partner P.Loganathan
73-D West Colony
Kumarapalayam,
Namakkal District. ..Appellant/Plaintiff

Vs.

A.Lakshmanan ..Respondent/Defendant

Appeal suit filed under Section 96 of the Civil Procedure Code, against the judgment and decree dated 8.6.2001 in O.S.No.2 of 1999 on the file of the Court of Principal District Judge, Erode.

For Appellant : Mr.K.Chandra Mouli, S.C.
for A.Muthukumar

For Respondent : Mr.N.Manokaran

J U D G M E N T

The appellant/plaintiff has filed this appeal as against the judgment and decree dated 8.6.2001 made in O.S.No.2 of 1999 on the file of learned Principal District Judge, Erode.

2.The short facts of the appellant/plaintiff's case are as below:

(i)The appellant/plaintiff, a firm registered under the Indian Partnership Act as two partners (1) N.Nachimuthu and (2) P.Loganathan. The partnership deed has been duly registered on 18.3.1997. The partners of the appellant/plaintiff firm formed the appellant firm in the name and style of "Shri Pattathu Amman Textiles" as per their original partnership agreement dated 29.101980. The business has commenced from 20.10.1980. The firm has been registered under the TN General Sales Tax Act, 1959 and also under Central Sales Tax Act, 1956.

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(ii)The appellant/plaintiff is one of the leading manufacturers and merchants of textile itself goes from the textile town of Kumarapalayam for more than 18 years and they are manufacturing handloom textile lungis and marketing them throughout India. The appellant/plaintiff has acquired considerable Good Will not only among the trading community but also among the purchasing public cents they maintain very high quality of raw materials and yarn for the lungies sold by them. With a view to protect Good Will and reputation of their quality lungies, the appellant in the year 1984 has honestly adopted a distinctive trade mark consistent of a device of an Aeroplane with the word jet brand reputed in English, Tamil and Hindi in blue, red and yellow colour combination. The appellant has applied for the registration of the Trade Mark as per the relevant provisions of Trade and Merchandise Mark Act, 1958 before the Registrar of Trade marks at Chennai on 02.02.1987 in clause 24 in respect of textile cloth which has been numbered as Appl.No.467004. The Trade mark has been registered and has been duly renewed and the same is in force and still remains on the Registrar of Trade Mark. The legal certificate of registration issued by the Registrar of Trade mark has been filed.

(iii)The appellant/plaintiff's turn over for the 5 years are mentioned as follows:

For the year 1993-94	Rs.2,90,11,360.00 (crores)
For the year 1994-95	Rs.2,94,05,129.25 (crores)
For the year 1995-96	Rs.2,56,74,784.75 (crores)
For the year 1996-97	Rs.3,37,62,860.00 (crores)
For the year 1997-98	Rs.2,65,58,875.00 (crores)

(iv)After seeing the hard earned Goodwill and reputation of the appellant/ plaintiff Trade mark a few dishonest traders from the textile town of Kumarapalayam recently have started affixing a deceptively similar trade mark as that of the appellant's mark on their products such as lungies of inferior quality and started selling them in the market as that of the appellant. By this act of infringement and passing off, they have not only encroached upon the hard Goodwill of the appellant, but also has brought down the sales figures. The damage caused to the reputation of the appellant/plaintiff's Trade mark cannot be compensated in terms of money alone easily. The respondent/defendant and others have no right to use any Trade mark, which is identical with and or similar to the Trade mark of the plaintiff.

(v)The literary population of our country is only 51% and that too English knowing persons are only 19%. Most of the customers of the appellant are purchasing the quality lungies manufactured by it,

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by looking at the device of the Aeroplane, the placement of the words of the label and by the colour combination of the plaintiff's Trade mark.

(vi)The appellant/plaintiff recently has noticed that the respondent/ defendant has started selling their inferior quality of lungies deceptively, similar to that of the Trade mark of the appellant and the appellant has issued a warning notice to the trading name of the respondent/defendant on 19.2.1997 and no reply has been sent.

(vii)A perusal of the respondent/defendant's label which consists of 'Naya Jet Brand', the manner of placement of the device of Aeroplane, the colour combination of the label in blue, red and yellow the size of the label, the placement of the trading style indicate that the respondent/defendant has dishonestly adopted this deceptively label with a calculated intention to deceive the unwary purchaser of ordinary intelligence. A comparison will show that the respondent/defendant has added only the word "NAYA" as extra in his label by imitating the features of the appellant/plaintiff's label. The respondent/defendant has purposely adopted the trading style similar to that of the appellant. Based on the police complaint dated 15.12.1997 at the Erode Police Station, an FIR No.2286/97 has been registered under Section 78 and 79 of the Trade and Merchandise Mark Act under Section 420 I.P.C. Some incriminating properties were seized by the police and the criminal investigation is pending. On 21.12.1998 the respondent/defendant has filed a suit at the First Additional District Munsif Court, Erode in O.S.No.666 of 1998 praying for the relief of declaration and consequent injunction restraining the appellant/plaintiff in the suit from preventing the respondent/defendant from doing the business under the name and style of 'Naya Jet Brand Lungies' Sri Periyur Amman Textiles, South India with the respondent's label. If the respondent/defendant is not restrained by means of a permanent injunction, the appellant/plaintiff cannot continue their business of selling lungies under the Trade mark of JET Brand and irreparable damage and loss will occur, which cannot be easily compensated in terms of money. The respondent/defendant is liable to pay damages to the appellant/plaintiff.

(viii)The damages can be ascertained only on production of accounts of the respondent/defendant from the financial year 1996-97. Yet the appellant tentatively estimates the value of the compensation by way of damages at Rs.1000/- and paying a Court fee for it and it undertakes to pay the difference of Court fees after ascertaining the exact amount of damages. Hence, the suit is laid for the grant of permanent injunction restraining the respondent/defendant, his men, agents, dealers, stockists assigners and others claiming under the respondent/defendant from using or attempting to use or enabling others to use the word NAYA JET, the device of the Aeroplane or in

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combination thereof, and/or in any other Trade mark identical or deceptively similar or in any other manner infringing the appellant/plaintiff's Trade mark registered in Regn.No.467004 in Clause 24 in respect of Textile cloth including lungies and for the relief of permanent injunction restraining the respondent/defendant, his agents, dealers, stockists and claiming others thereunder from passing off, or attempting to pass off or from enabling others to pass off the defendant goods and for an issuance of a direction to the respondent/defendant to produce before the Court all his accounts of sales and profits for determining the ultimate compensation payable by the respondent/defendant to the appellant/ plaintiff as damages etc.

3.The respondent/defendant in the written statement has inter alia taken the pleas that nobody in the public will say that the lungies of the appellant/ plaintiff are superior qualities and the lungies of the respondent/defendant are of inferior one and as a matter of fact, the lungies of the respondent/defendant do have a good reputation and an actual among the public throughout India and that the respondent/defendant has started the business with the 'Naya Jet Brand' label only on 01.2.1997, having entirely different from the quality of the appellant such as 'NAYA JET BRAND' with different colours and figures of the figure brand represented in English, Tamil and Hindi in dark blue, orange, red and yellow colour with the attachment of different figures of the 'NAYA GET BRAND' colour combination and there are lot of differences of the figures of the Jet Brand of the appellant and Naya Jet Brand of the respondent/defendant in all aspects, not only to the figures but also the words and the brand and that the public at present both the literate and illiterate's can easily find out the label of the respondent/defendant, without any difficulty and a wavering mind among and the respondent/defendant has never caused any kind of damages to the appellant/plaintiff not only by bringing down the sales of the appellant lungies etc. and that he has been selling his own brand viz. 'NAYA JET BRAND' till the date on 15.7.1999 and from 16.7.1999 onwards the respondent/defendant is selling the lungies in the name of 'QUEEN JET BRAND' which is entirely different from the quality, quantity and different from that of the appellant's Jet Brand lungies till now, by the firm Sri Ram Lakshman Tex, Sri Periyur Amman Textiles, Komarapalayam and hence, the respondent has any intention to cause any damage to the appellant/plaintiff in any manner and that the appellant/plaintiff is not entitled to seek the relief of injunction in any manner against him and without any valid reason and evidence, the appellant is not entitled to claim the relief of damages from him and also the appellant is not entitled to the relief in directing the respondent/defendant to produce the accounts from the financial year 1996-97 and further the appellant is not entitled to claim a compensation by means of damages at Rs.1000/- etc.

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4.Before the trial Court, on the side of appellant/plaintiff witness P.W.1 has been examined and Exs.A.1 to A.40 have been marked and on the side of respondent/defendant, witness D.W.1 has been examined and no document has been marked.

5.The trial Court on an appreciation of oral and documentary evidence and after scrutinising the available materials on record has come to the conclusion that the appellant/plaintiff are not entitled to claim the reliefs prayed for and resultantly, dismissed the suit without costs.

6.Aggrieved against the said dismissal of the suit by the trial Court, the appellant/plaintiff has projected this appeal before this Court.

7.The points that arise for determination in this appeal are:

1.Whether the respondent/defendant's trade mark is deceptively similar to that of the appellant/plaintiff's trade mark?

2.Whether the appellant/plaintiff is entitled to the relief of permanent injunction?

3.Whether the appellant/plaintiff is entitled to the relief of damages and if so what is the quantum of damages?

4.Whether the respondent/defendant is liable to produce the accounts from the financial year 1996-97?

8.Contentions, discussions and findings:

According to the learned counsel for the appellant/plaintiff, the trial Court has committed an error in coming to the conclusion that the label of the respondent/defendant 'NAYA JET BRAND' is different from the appellant/ plaintiff's label 'JET BRAND' even before discussing the evidence of the case and the comparison of the concerned labels and in fact, the overwhelming oral and documentary evidence in the case will point out that the respondent/defendant has infringed the appellant/plaintiff's Trade mark and this fact of the matter has not been taken note of by the trial Court and moreover, the trial Court has committed an error in assuming that the appellant/plaintiff has got his trade mark registered on 10.3.1999 ignoring the fact that the said date is the one on which a true copy of the entry in the registry of trade marks pertaining to appellant has been furnished and the annexure to Ex.B.39 refers to the date of grant of certificate and the subsequent renewals clearly prove that the appellant's trade mark has been registered as early as in 1987 and thereafter, renewed and this has not been taken note of by the trial Court in a proper perspective and in fact, any purchaser cannot easily differentiate the

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respondent/defendant's lungies with that of the appellant/plaintiff and that the respondent/defendant's label bears a close resemblance to that of the appellant /plaintiff and these facts have not been looked into by the trial Court in a proper manner and added further, on the date of the suit the trade mark of the appellant/plaintiff has already been registered and the same has been renewed in the year 1994 and therefore, prays for allowing the appeal in the interest of justice.

9.The learned counsel for the appellant contends that when once the appellant/plaintiff establish a case that the respondent/defendant has adopted a label of the appellant in a deceptive way then it is the end of the matter and that the appellant/plaintiff is to be given the reliefs prayed for in the suit automatically. In support of his contention that the respondent/defendant has adopted the label of the appellant/plaintiff in a deceptive way and therefore, there is infringement of appellant/plaintiff's registered trade mark by the respondent/defendant, the learned counsel for the appellant relies on the Hon'ble Supreme Court decision Parle Products (P) Limited V.J.P. and Company, Mysore in AIR 1972 Supreme Court 1359 wherein it is observed as follows:

> "To decide the question as to whether the plaintiffs' right to a trade mark has been infringed in a particular case, the approach must not be that in an action for passing off goods of the defendant as and for those of the plaintiff. In order to come to the conclusion whether one mark is deceptively similar to another, the broad and essential features of the two are to be considered. They should not be placed side by side to find out if there are any differences in the design and if so, whether they are of such character as to prevent one design from being mistaken for the other. It would be enough if the impugned mark bears such an overall similarity to the registered mark as would be likely to mislead a person usually dealing with one to accept the other if offered to him. It is of no use to note on how many points there is similarity and in how many others there is absence of it. AIR 1965 SC 980, Rel. on; R.F.A.No.170 of 1963, D/- 5-7-1966 (Mys.) Reversed."

10.He also cites the decision of this Court R.Gopalakrishnan V. M/s.Venkateshwara Camphor Works, Coimbatore in 2000 (IV) CTC 222 wherein it is held that 'the appellant's carton is with figure "Lord Krishna" while respondent's carton is with figure "Lord Muruga" and the Gods in both cartons are positioned on Lotus flower with water in

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background and the colour scheme is also identical and the words and sequence in which they are used in carton are also similar and such similarities point that the respondent while designing carton had kept in mind the appellant's carton and similarities cannot be coincidence and the attention to similarities should be more than to dissimilarities when there is dishonesty on the part of person infringing trade mark and the similarities in colour schemes sequence in which are used in both cartons establish dishonesty and that the trade mark is infringed and as such the suit is liable to be decreed.'

11.Another decision of this Court in Godavai Match Industries, Mamasapuram by its Proprietor and 4 others V. The Comorin Match Industries Pvt. Limited, Kovilpatti by its Managing Director 2001 (1) CTC at page 633 is relied on the side of the appellant to the effect that 'plaintiff using label "Kisan" in safety match boxes manufactured and sold by them and the defendants used label "Krise Race" and the plaintiff label contain picture of man shown to be ploughing field in standing posture with two bulls attached to plough under his control with whip in right hand and head gear made on cloth and the defendant label contains picture of man seated on chariot pulled by two bulls under his control and man is shown with whip in right hand and headgear made of cloth and the plaintiffs label contains tiller of soil and defendants label contains man in chariot and the common features alone should be taken into account to decide similarity between two labels and other small differences should not be taken into consideration and the mere fact that several other manufacturers are shown to be using similar label would not deprive plaintiffs of his right if case is made out and common features in both labels will enter in mind of unwary purchaser with imperfect recollection and the Court should have in mind point of view of buyer and buyer's interest alone in deciding infringement and Court should also consider whether registered trade mark are in same goods and also it shall have regard to class of buyers and the market for match box is from people whose illiteracy level is very high and the Court should have in mind man of intelligence below par and unwary purchaser with imperfect collection of memory and the effective impression in mind of buyer who go in for match boxes would be dominant and the unwary purchaser does not have an opportunity of seeing infringed trade marks and registered trade mark side by side and the words found in the label of plaintiff and defendant though totally dissimilar, cannot mean that there would be no confusion in mind of buyer on looking at two labels and the service man in both labels in shown to be having headgear made of cloth and picture of two bulls postioned in same place in same direction controlled by man with whip in right hand and the defendants label is nearly resembling with registered trade mark of plaintiff and there is likelihood of deception or confusion in mind of unwary of purchaser and the plaintiff has statutory right to protect his trade mark.'

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12.The learned counsel for the appellant draws the attention of this Court M/s.Devi Pesticides Private Limited V. M/s.Shiv Agro Chemicals Industries 2006-3-L.W. 350 and 351 whereunder it is held that 'the Court is satisfied that the applicant has made out that it is a clear case of infringement of their Trademark BOOM PLUS by the respondent by using their Trade mark SUPER BOOM and that the respondent has committed an act of passing off their goods as that of applicant by using their Trademark SUPERBOOM, which is deceptively similar and identical to the plaintiff's trademark BOOM PLUS and by using phonetically similar mark and making the unwary consumers to believe that the product of the respondent originates from that of the applicant, thus committed an act of passing off infringement of trademark.'

13.Countering the submissions of the learned counsel for the appellant, the learned counsel for the respondent submits that the respondent/defendant has commenced his business with the label 'NAYA JET BRAND' on 01.2.1997 which is wholly different from the quality of the appellant/plaintiff such as 'NAYA JET BRAND' with different colours and figures representing in English, Tamil and HIndi in dark blue, orange, red and yellow colour with the attachment of different figures of the 'NAYA JET BRAND' colour combination and there are large differences of the figures of 'JET BRAND' of the appellant/plaintiff and 'NAYA JET BRAND' of the respondent/defendant in all aspects including the words and brand and the device of Aeroplane and the placement of the words on the label and by the colour combination of the respondent/defendant are entirely different from that of the appellant/plaintiff's label and moreover, the respondent/ defendant has been selling his own brand of lungies with the brand name 'NAYA JET BRAND' till 15.7.1999 and from 16.7.1999. He is selling the same under the name of 'QUEEN JET BRAND' which is totally different from the quality and quantity of the appellant/plaintiff's Jet Brand lungies and therefore, the appellant/plaintiff is not entitled to the reliefs prayed for in the plaint inasmuch as the respondent/defendant has not committed any act of infringement of trade mark.

14.Also the learned counsel for the respondent/defendant informs this Court that earlier the appellant/plaintiff has filed a suit O.S.No.131 of 1990 against 8 individuals for selling lungies in the brand name of 'AIR JET BRAND' which has been dismissed by the trial Court etc.

15.The learned counsel for the respondent/defendant cites the decision M/s. National Chemicals and Colour Company and others V. Reckitt and Colman of India Limited and another in AIR 1991 BOMBAY 76 whereunder it is held that 'one cannot compare two marks by putting them side by side and by trying to find out similarities and differences in them and what one has to see is overall impression given by the mark in minds of members of general public.' He also

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relies on the decision in Century Traders V. Roshan Lal Duggar and Company AIR 1978 Delhi 250 wherein it is held that 'In an action for passing off in order to succeed in getting an interim injunction the plaintiff has to establish user of the mark prior in point of time than the impugned user by the defendants. The registration of the mark or similar mark prior in point of time to user by the plaintiff is irrelevant in an action for passing off and the mere presence of the mark in the register maintained by the trade mark registry does not prove its user by the persons in whose names the mark is registered and is irrelevant for the purposes of deciding the application for interim injunction unless evidence has been led or is available of user of their registered trade mark. ILR (1976) 1 Delhi 278 and AIR 1965 Bom 35 and AIR 1960 SC 142, Relied on; Order D/- 30.9.1976 (Delhi) in Suit No.381 of 1976, Reversed.'

16.In the instant case on hand, the evidence of P.W.1 and R.W.1 assume significance in the considered opinion of this Court. Indeed, P.W.1 (Partner of the appellant/plaintiff firm) in his evidence has deposed that the appellant/plaintiff from the year 1980 onwards is doing textile business in the name of 'Sri Pattatharasiamman Textiles' by affixing Jet brand label and they are manufacturing cotton lungies and they are doing business in different parts of India like Bihar, Orissa, West Bengal, Kerala, Andra, Karnataka, Tamil Nadu and Pondicherry and their label will be in the form of Aeroplane flying and the public after seeing the label will produce their products and from the year 1984 they have started using the label and they have submitted application bearing No.467004 in the year 1987 and the same has been registered in the year 1994 by allotting the same number and that the trademark has been registered and a legal certificate has been issued in their favour and the labels used by them are Ex.A.1 and A.2 and that the respondent/defendant has manufactured the duplicate labels like that of their labels and by fixing the said duplicate label they are selling the same and the duplicate label is Ex.A.3 and by using the duplicate label the respondent/defendant has benefited immensely and even the educated people are duped and confused in regard to the labels of the respondent and the office copy of the legal notice dated 19.2.1997 is Ex.A.4 and the plaint copy in O.S.No.666 of 1998 on the file of Second Additional District Munsif, Erode is Ex.A.6.

17.P.W.1 during his cross examination has deposed that the appellant/ plaintiff is a partnership firm and he has filed the suit in his capacity as a partner and that he has given a complaint in Crime No.2486 of 1997 before the Erode Town Police and that he has furnished the name and address of 10 textiles and in that the respondent/defendant name does not find a place and that he has filed the original licence in O.S.No.1 of 1999 and the certified copy is Ex.A.39.

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18.D.W.1/the first defendant in his evidence has stated that he commenced his business in the name of 'NAYA JET' and that till date he has not conducted any sales and involved in the purchase after the commencement of his business under the brand 'NAYA JET' and thereafter, he started his business in the name of 'QUEEN JET BRAND' and in the business there is no sales or purchase and that in the plaint the date of Gazette Notification has not been mentioned and that the appellant/plaintiff can register his business only after the Gazette Publication and later on only a competent certificate will be issued and that Ex.B.39 has been issued on 10.3.1999 and the suit has been filed on 06.1.1999 and that the suit is not a valid one and further that he has not registered the 'NAYA JET BRAND' and that he has not filed any document to show in regard to the commencement or closure of 'NAYA JET BRAND' business and that he has not enquired on what date the label of appellant/plaintiff has been registered and that he does not know whether the business turnover of the appellant/plaintiff for the 1993 to 1998 filed into Court and he does not know from what date the appellant is doing his business.

19.It is to be borne in mind that a case of falsifying a trademark will arise, when there is genuine mark, and when an individual without the consent of the Proprietor, makes that the trademark or deceptively similar mark. A mark shall be deemed to be deceptively similar to another mark if it so only resemblance that other mark as to be likely to deceive or cause confusion. As per Section 2(i)(h) of the Trade Marks Act, 1999. After all, the function of a trade mark is to give an indication to the purchaser of the trade source from which the goods come or the trade hands through which they pass on their way to the market. Moreover, the trade mark is simply an intimation upon the goods that they are the goods of the owner of the mark. A trader acquires a valuable right of property in a distinctive mark merely by using it upon in connection with the goods irrespective of the length of such user and the extent of his trade. In fact, the trader is entitled to protection since, the product has assumed a vendible character when the same is launched in the market. In between the two competitors who are each desirous of employing such a mark is entirely a question of who gets their first.

20.This Court points out the decision in Konar Publications V. Madras Palaniappa Brothers and others (2008) 3 MLJ 10 wherein it is inter alia held that 'the registered user can take proceeding in his known name to prevent infringement of trademark and the use of trademark can also be permitted do hors the provisions of the Act by grant of licence by registered proprietor to the proposed user and such licence is governed by common law.' Another decision of this Court in Jadayapppa Mudaliar V. K.B.Venkatachalam 1990 2 MLJ 423 at page 424 it is held that 'the proper test to decide whether a Mark which was originally a Trade Mark has become publici juris is to see whether the use of it by other persons is still calculated to deceive the public. It is also to be seen whether the Mark has become so

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public and in such universal use that nobody can be deceived of it or can be induced from the use of it to believe that he is buying the goods of the original trader. To say that a mark has become common to the trade is another way of saying that it has ceased to be distinctive of a particular trader's goods. The Act does not expressly prohibit licensing of Trade Marks whether registered or unregistered. There is no need for a person to be a registered user as contemplated under the Act to use the registered Trade Mark as registered must be established as a fact on the material placed on record. Hence, the intention of the parties should have been looked into to find out what they have contracted among themselves. If the contract is looked into, clause 4 of the agreement clearly shows that the intention of the petitioners third parties is to go back on the said terms to remove the respondent's mark could only mean the ulterior motive on the part of the petitioners and nothing else. Therefore, it has to be held that the respondent had only a bona fide intention to use the registered trade mark in relation to the goods for which the registration is granted.'

21.In the decision of this Court in Soundarapandian Match Works V. M.Jayarama Chetty and others (2001) 2 MLJ 176 it is inter alia held as follows:

"The Court consider as to whether the similarities are sufficient to mislead the ordinary purchaser who is not expected or supposed to make a microscopic and minute examination of these differentiating features before he chooses to buy. The change of colour had made a lot of difference leading to similarity. Though the colour is not a feature of registration held by the plaintiff in an action for passing off. The Court only concerned with overall similarity and appearance and whether it could mislead or confuse the buyer. The plaintiff has no objection for the respondent to continue to manufacture their product under the very same registration No.262340 in which colour and the entire packing are totally different. But the packing which is now impugned, does result in misleading any ordinary buyer. The size of the box, the colour, the common trade name "Bulb", the images of the Bulb, similar colour of the sliding container, and the designs on the striking side are all features which are definitely or likely to create an impression in the mind of the buyer that both the products belong to the manufacturer. The design of both sides of packing being the sticking side for igniting the matches is of the same colour pattern and artistic work of four rows of "heart" shape figures which are identical. Such a similarity would not have been an innocent or accidental outcome. There are no doubt, certain variations between the two products, but they are not sufficient to dislodge the immediate response of the buyer who would undoubtedly be led to mistake the product as belonging to the plaintiff."

22.In the decision M/s.Suraj Agencies V. M/s.Southern India Trading Agency (India) 1993 2 MLJ at page 115 it is observed that

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'Trade Marks "Suraj Regal" and Regaul" held by trial court to be deceptively similar and pending appeal, petition has been filed to use trade mark 'Suraj Regal' with the word 'Suraj' printed in bold type and the permission has been refused on the ground that printing of the word "Suraj" in big type would not alter situation.'

23.In the decision in Aravind Laboratories V. V.A.Samy Chemical Works 1994 (1) MLJ 174 at page 175 wherein it is inter alia held that '... In other words, the plaintiff may lay the foundation of actual damage and give proof of it before a decree for any substantial damages is given to it. True, the onus will be on the defendant to satisfy the court that he was unaware and had no reasonable ground of believing that the trade mark of the plaintiff was on the register or that the plaintiff was the registered user or that the trade mark of the plaintiff was on the register or that the plaintiff was the registered user or that the trade mark of the plaintiff was in use and that when he became aware of the existence and nature of the plaintiff's right in the trade mark, he immediately stopped to use the trade mark complained of. But this onus will shift on the defendant only after the plaintiff discharged his burden by establishing that the defendant made profits by using a trade mark in violation of the plaintiff's right. This the plaintiff has to do before the defendant is asked to establish that he was unaware and had no reasonable ground for believing at the time when he commenced using the trade mark that the trade mark of the plaintiff was on the registers or that the plaintiff was the registered user or that the trade mark of the plaintiff was in use from before and that he had stopped using the trade mark complained of, when he came to know of the existence and nature of the plaintiff's trade mark.'

24.In an infringement action the burden is on the plaintiff to establish similarity. A Court of law has to be satisfied not merely that there is a possibility of confusion, but that there is a real tangible danger of confusion if the mark which is sought to be registered is put on the registry. Confusion does not necessarily mean that one man will be injured and the another will gain illicit benefit, but there will be confusion in the mind of the public which will lead to confusion in the goods as per decision Pianotist Appln. (1906) 23 RPC 774 at 777. It is true that the issue of similarity between the two trade marks are the likelihood of deception or confusion arising from its use is not to be decided in vacuo but has to be determined in the backdrop of surrounding circumstances. The following ought to be borne in mind:

(a)the nature of the marks, i.e. whether they are words, coined or descriptive or non-descriptive, surname or geographical name, devices, letters or numerals or a combination of two or more of the aforesaid,

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(b)the degree of resemblance between the marks and essential features, i.e. similarity in phonetic, visual and in idea,

(c)the nature of the goods in respect of which they are used or likely to be used as trade marks,

(d)the similarity in the nature, character, and purpose of the goods of the rival traders,

(e)the class of purchasers who are likely to buy the goods containing the marks their level of education and intelligence, and the degree of care they are likely to exercise in purchasing the goods,

(f)the mode of purchase of the goods or of placing orders for the goods,

(g)any other surrounding circumstances

The importance to be attached to one will depend upon the relative importance of other factors.

25.For a deceptive similarity, the resemblance must be such as to be likely to deceive or cause confusion. What degree of resemblance is necessary is, from the nature of things, a matter incapable of definition a priori. Each case must depend upon on its own facts and circumstances, in the considered opinion. The risk of deceptive and confusion ought not to be fancifully and it must be a real one the decree of similarity of the two marks in sight and sound, looking not just at the registered mark as a whole but also at its salient or essential features or the idea behind it, the whole range of potential customers for the goods protected by the registered mark, and not just customers for the goods of the particular type marked by the defendant, the nature and kind of customer likely to purchase the plaintiffs' and defendants' goods; the manner in which the purchasers of the goods are generally made. An allowance shall be made for imperfect recollection of details on the part of individual ordinary customers. Generally speaking, all the circumstances of the trades shall be considered. Once a mark is shown to infringe, the defendant cannot escape his liability by showing that by something outside the actual mark itself he has distinguished its goods from those of the registered Proprietor as per decision Saville Perfumery V. June (1941) 58 RPC 147 at 161. Additions are sometimes made to the infringing mark which are either not easily visible or are so inconspicuous that they could be seen only by careful perusal which is not expected of an ordinary individual customer. In such matters, the inconspicuous additions may point out a fraudulent intent and in short 'the act speaks for itself'.

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26.It is not out of place to point out that in S.Venkateswaran's 'the Law of Trade and Merchandise Marks', 1963 Edition at page 521, it is mentioned that 'in cases of infringement the onus is on the registered Proprietor of the Mark to show that the defendant's mark is deceptively similar to his registered trademark.' Also in the absence of identical user a prima facie case of likelihood of deception or confusion must first be made out by the plaintiff before the Court could intervene and thereafter, the burden is on the defendant to show that the use complaint is not likely to deceive of confusion.

27.This Court points out the decision of Hon'ble Supreme Court in Heinz Italia and another V. Dabur India Limited (2007) 5 MLJ 594 whereby and whereunder it is observed as follows:

> "In a suit against infringement of trademark, where ad interim injunction is sought for, the case of prior user of the mark is a fact which is to be considered and the colour scheme and overall effect of packaging has to be seen.
>
> In an application for ad interim injunction, in a suit against infringement of trademark, it has to be seen whether there is a remarkable phonetic similarity in the two words and the test is as to whether a particular mark and the packaging is so similar that it can easily confuse a purchaser and the enviable reputation acquired by the particular mark in the market is sought to be exploited by the opposite party."

28.In the instant case on hand, Ex.A.1 is the appellant/plaintiff's label under the name of 'JET BRAND' in English and the same being printed in Tamil and the register number of the trade mark is mentioned as No.467004. In Ex.A.2 the appellant/plaintiff's four labels used in the business are seen in one of the labels in Ex.A.2 it is categorically mentioned that 'BEWARE OF DUPLICATES USE ALWAYS ORIGINAL JET (SPT) LUNGIES'. In the very same document Ex.A.2, the appellant/plaintiff's another partner's photo is seen and a caution is given in English to the buyers 'PLEASE ALWAYS BUY LUNGIES SEEING OUR PHOTO LABEL'. Over and above the letters in English in the partner's photo in Ex.A.2 Hindi words are also printed. Ex.A.3 is the respondent/defendant's label in the name 'NAYA JET BRAND' with an Aeroplane flying and the said brand has been printed in Tamil and Hindi language also. Ex.A.4 is the appellant/plaintiff's lawyer's notice dated 19.2.1997 issued to M/s.Ram Lakshman Tex. D.No.28 D/6 Kalaivani Street, Kullan Kadu, Komarapalayam- 638 183. In the said notice, it is among other things mentioned that the appellant/plaintiff is one of the leading manufacturers and merchants of quality handloom and powerloom lungies

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from the Komarapalayam Textile Town, selling lungies all over India for more than 10 years and in order to distinguish their quality lungies, they have honestly and in the course of the trade adopted a distinctive trade mark consisting of a label which consists of the word JET BRAND with device of Jet aeroplane and due to the maintenance of high quality and due to the vast sales promotional net work and due to honest trade practices, the trade make acquired considerable goodwill and reputation in the market and the trading community in particular, the purchasing public in general associate the trade mark only with that of the appellant/plaintiff and further that they have registered the trade mark under the provisions of Trade and Merchandise Marks Act, 1958 in Cl.24 in Regd TM No.467 004 for textile cloth which registration is renewed and still remains on the Register of Trade Mark and moreover, the appellant/plaintiff has come across a trade mark consisting of the word 'NAYA JET BRAND' in English, Hindi and in Tamil in the same colour combination as that of the appellant with device of a Jet plane which is deceptively similar to that of the appellant for lungies of inferior quality under the trading style of Sri Periyur Amman Textile South India which originates from your concern and by selling the inferior lungies under a deceptively similar trade mark the respondent/defendant has committed an act of infringement and passing off which is punishable under the provisions of the Trade and Merchandise Marks Act, 1958. Ex.A.5 is the Xerox copy of FIR wherein the complainant is P.Loganathan who is none other than the P.W.1 in the civil case. In Ex.A.5 the 11 respondents are mentioned but the name of the respondent/defendant in O.S.No.2 of 1999 is not found.

29.Ex.A.38 is the certified copy of decree passed in O.S.No.666 of 1998 by the learned I Additional District Munsif, Erode dated 10.08.1999 and a perusal of the same shows that the said suit has been filed by the defendant/respondent in O.S.No.2 of 1999 on the file of Principal District Judge, Erode figuring as plaintiff and the same has been dismissed as withdrawn without costs, with a liberty to file fresh suit for the same cause of action. Ex.A.39 is the Xerox copy of the Trade Mark Certificate issued by the competent authority. On the reverse side of Ex.A.39, the appellant/plaintiff's name is shown as the Proprietor and that the Registration Number is mentioned as 467004 and that the registration date is noted as 02.2.1987 and the renewal date is described as 02.2.1994 and the Goods Description is satisfied as 'TEXTILE CLOTH'. In Ex.A.39 registered trade mark details the appellant/ plaintiff's label 'JET BRAND' with a flying aeroplane is mentioned in English, Tamil and Hindi languages. Moreover, it is candidly stated that 'the Registration of this trademark shall give no right to the exclusive use of the word "Brand" and the registration renewed for a period of 7 years from 2nd February 1994'. Therefore, it is quite clear from Ex.A.39 that the status of the 'JET BRAND' mark is a registered one and the same is in Journal No.1058 and the mark type is described as device. Ex.A.40 is

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the label of respondent/defendant's textiles under the name of 'QUEEN JET BRAND' in English, Tamil and Hindi words with an aeroplane flying.

30.At this stage, it is worthwhile to recollect the evidence of D.W.1 that he has not registered the 'NAYA JET BRAND' and that he is doing the business under the brand name 'QUEEN JET BRAND' and further he has not produced any document to show the commencement of 'NAYA JET BRAND' and its closure and moreover, he is not doing business for the last two, three years and that he has no objection for the appellant/plaintiff seeking a relief of injunction against him for doing the business under the name 'JET BRAND'.

31.The learned counsel for the appellant/plaintiff has produced a true original certificate of the entry in the register of trade marks relating to trade marks No.467004 in clause 24 and the registration date is mentioned as 02.2.1987 and the renewal date is mentioned as 2001 and quite significantly it is mentioned that 'REGISTRATION RENEWED FOR A PERIOD OF 7 YEARS FROM 2ND FEBRUARY, 1994 ADVERTISED IN JOURNAL N 1163 and THE REGISTRATION RENEWED FOR A PERIOD OF 7 YEARS FROM 2ND FEBRUARY, 2001 ADVERTISED IN JOURNAL NO. 1247.' Moreover, in the said true copy of the entry under the caption 'Register Trade Marks Details for 467004 on the right hand side bottom the appellant/plaintiff's brand is mentioned as 'JET BRAND' in English and also in Tamil with a device of aeroplane flying and also the brand name figuring in Hindi. A perusal of appellant/plaintiff's plaint in O.S.No.2 of 1999 on the file of the learned Principal District Judge, Erode shows that the plaintiff has been represented by its partner P.Loganathan who has been examined as P.W.1 in the case. Notwithstanding the fact that P.W.1 in his evidence has stated that there is another partner by name, Nachimuthu in the appellant/plaintiff's firm apart from him. Inasmuch as the appellant/plaintiff has been represented by a single partner (examined as P.W.1 in the case) and the suit filed before the trial Court by the appellant/plaintiff is not barred as per Section 69(2) of the Partnership Act for enforcing a statutory right or a common law right based on Tort in the considered opinion of this Court.

32.Admittedly, the suit before the trial Court has been filed on 06.1.1999. Even though Ex.A.39 Xerox true copy of the entry in Register of Trade Mark is dated 10.3.1999, the date of registration bears a date 02.2.1987 and therefore, one has to take the registration date only as 02.2.1987 and not as 10.03.1999 as construed by the trial Court. In fact, in Ex.A.39 the date mentioned as 10th day of March 1999 a reference to the date of true copy of the entry made in the register of trade marks and by no stretch of imagination, the said issuance of true copy of Ex.A.39 dated 10.3.1999 cannot take the place of the registration date of the appellant/plaintiff's trade mark label since in the annexure to Ex.A.39 on the reverse, it is categorically mentioned that the registration date is 02.2.1987. As a matter of fact, even in the

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certificate dated 22.03.2001 produced by the appellant/plaintiff before this Court it is seen that the registration date is mentioned as 02.2.1987 and the renewal date is mentioned as 02.2.2001 etc. Therefore, it is candidly clear that as on the date of appellant/ plaintiff filling the suit on 06.1.1999 the appellant/plaintiff has registered his label 'JET BRAND' with a flying aeroplane as early as on 02.2.1987 and the contra finding of the trial Court is not correct per se in law. Furthermore, even though the appellant/plaintiff has not examined atleast any single buyers as a witness before the trial Court to establish that the label 'NAYA JET BRAND' employed and used by the respondent/defendant is likely to mislead the customers when they entertain to buy 'JET BRAND' lungies of the appellant/ plaintiff, the same is not fatal to the case, in the considered opinion of this Court.

33.Even though the respondent/defendant has taken a stand that he has commenced his business with the label 'NAYA JET BRAND' on 01.2.1997 having entirely different from the quality of plaintiff such as 'NAYA JET BRAND' with different colours and figures of the figure brand represented in English, Tamil and Hindi in dark blue, orange, red and yellow colour with attachment of each figures of 'NAYA JET BRAND' colour combination and also a plea to the effect that there are lot of differences of the figures of 'JET BRAND' of the plaintiff and 'NAYA JET BRAND' of the defendant in all aspects a cursory look of the appellant/plaintiff's label Ex.A.1 and the Ex.A.3 label of the respondent/ defendant, this Court is of the considered view that the respondent/defendant has adopted the appellant/plaintiff's label Ex.A.1 with small/minute changes in regard to the visual of flying of aeroplane and adding a word 'NAYA' before the word 'JET BRAND' in English and further there is phonetic similarity of 'JET BRAND' except the word 'NAYA' and these will not alter the situation in any way in favour of respondent/defendant including the one the respondent/defendant even selling the lungies in the name of 'QUEEN JET BRAND' from 16.7.1999 with a device of aeroplane flying will not enure to his benefit and accordingly, this Court holds that the respondent/defendant with a dishonest intention has adopted the trading style label similar to that of appellant/plaintiff and has practised deception and has committed an act of passing off infringement of trade mark of the appellant/plaintiff and resultantly, the appellant/plaintiff is entitled to the relief of permanent injunction restraining the respondent/ defendant, his men, agents etc. claiming under him from using or attempting to use or enabling others to use the word NAYA JET the devise of the aeroplane or in combination thereof and (or in any other Trade Mark identical or deceptively similar or in any other manner infringing the plaintiffs Trade mark registered in Regn.No.467004 in clause 24 in respect of Textile cloth including lungies and further that the respondent/defendant is directed to produce before the trial Court all his accounts of sales and profits from the year 1996-1997 for determining the damages/compensation

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payable by him to the appellant/plaintiff and in this regard, the appellant/plaintiff is directed to file necessary application by means of separate proceeding and the trial Court shall determine the same in the manner known to law and the points 1 to 4 are answered accordingly thereby perforcing this Court to interfere with the findings rendered by the trial Court and consequently allows the appeal to promote substantial cause of justice.

34.In fine, for the foregoing reasons, the Appeal is allowed. The judgment and decree of the trial Court made in O.S.No.2 of 1999 dated 8.6.2001 are set aside to prevent an aberration of justice. Having regard to the facts and circumstances of the case, the parties are directed to bear their own costs in this appeal.

sd/-
Asst.Registrar

/true copy/

Sub Asst.Registrar

sgl

To

1. The Principal District Judge,
   Erode District.

2. The Section Officer,
   V.R. Section,
   High Court, Madras.

+ 1 c.c. to Mr. N. Manokaran, Advocate. S.R.No.29279.

+ 1 c.c. to Mr. A. Muthukumar, Advocate. S.R.No.28946.

Judgment in
A.S.No.1010 of 2001

GV (CO)
GSK 21.07.2009.

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